

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Barbara Ensoli et al.	Confirmation No.:	3028
Serial No.:	10/577,974	Art Unit:	1648
Filed:	May 30, 2007	Examiner:	Nicole Erin Kinsey White
Customer No.:	21559		
Title:	Use of Microparticles for Antigen Delivery		

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO WITHDRAW FINALITY UNDER 37 C.F.R. § 1.181

Applicants request withdrawal of finality of the Office action issued in connection with the above-referenced case on April 16, 2009.

Under M.P.E.P. § 706.07(a), a “second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)” and “[a] second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed.”

The facts of this case are as follows. On April 16, 2009, a final Office action was issued rejecting claims 1-9 and 11 for obviousness and provisionally rejecting claims 1-9 and 11 for obviousness-type double patenting. Applicants filed a reply on August 17, 2009, which included arguments against the Examiner’s *prima facie* case of obviousness, legal arguments in support of previously presented evidence of non-obviousness, and an amendment of claim 1 to incorporate the limitations of dependent claim 9. In an Advisory action dated October 2, 2009, the Examiner indicted that Applicants’ amendment had been entered and cited, for the first time, U.S. Patent No. 6,753,015 in connection with the outstanding obviousness rejection (see page 5, last full paragraph of the Advisory action). This reference was not previously cited by either the

Applicants or the Examiner, and no Form PTO 892 including this reference was provided with the Advisory action.

Because U.S. Patent No. 6,753,015 was first cited in an Advisory action, Applicants are procedurally restricted in their ability submit arguments and evidence in support of the patentability of the claims with respect to this reference. Applicants are entitled to full consideration of such arguments and evidence submitted in response to a non-final Office action, as well as a further opportunity to present additional arguments and evidence to prepare the case for appeal, if necessary.

The new citation of U.S. Patent No. 6,753,015 was not necessitated by a claim amendment or an Information Disclosure Statement file by the Applicants. Therefore, in accordance with M.P.E.P. § 706.7(a), the finality of the prior Office action should be withdrawn and a new, non-final Office action should be issued.

For these reasons, Applicants request withdrawal of finality. If there are any charges or any credits, kindly apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: October 28, 2009

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